

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion, is respectfully requested.

Claims 39-61 are pending. In the present amendment, Claims 39, 45, and 51 are currently amended. Support for the present amendment can be found in the originally filed specification, for example, at page 2, lines 2-6, at page 10, lines 18-25, and at page 11, line 16 to page 12, line 20. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claims 39, 40, 43-47, 49-54, and 57-61 were rejected under 35 U.S.C. § 112, first paragraph; Claims 39, 40, 43-47, 49-54, and 57-61 were rejected under 35 U.S.C. § 112, second paragraph; Claims 39, 40, 43, 44, 51-54, 57, and 58 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgson (U.S. Patent No. 3,645,835); Claims 45, 46, 50, and 60 were rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin (U.S. Patent No. 4,653,483); Claim 47 was rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin in view of Samuelsen et al. (WO 99/38929, hereinafter “Samuelsen”); Claim 49 was rejected under 35 U.S.C. § 103(a) as unpatentable over Clavin in view of Hodgson; and Claims 59 and 61 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hodgson in view of Berglund et al. (U.S. Patent No. 4,310,509, hereinafter “Berglund”).

Turning now to the rejections under 35 U.S.C. § 112, first and second paragraphs, it is noted that each of the independent claims, Claims 39, 45, and 51, recite “a double eyelid forming article of manufacture for forming a fold on an eyelid of a user.” As described in the specification, for example, at page 2, lines 2-6, at page 10, lines 18-25, and at page 11, line 16 to page 12, line 20, the fold is formed by stretching the article, attaching the article to the skin, and then releasing the article. When the article is released, its resilient shrinkability

overcomes the tension of the skin on the eyelid to break or lift the skin of the eyelid from the surface of the eyeball to form the fold.

Accordingly, the skin is necessarily stretched to be in the folded state. If the resilient shrinkability of the skin on the eyelid were *greater* than that of the tape member, then, as discussed below, the skin would wrinkle instead of staying in the folded state and the claimed invention would not work for its intended purpose. Therefore, it is respectfully submitted that the original specification supports the tape, string, or elongate member having a resilient shrinkability that is smaller than a resilient shrinkability of the skin on the eyelid to form the fold in a direction perpendicular to the longitudinal direction of the tape, string, or elongate member.

The Office Action next takes the position that the claim term “break the skin of the eyelid from a surface of an eyeball” is not supported by the written description. The original specification, for example, at page 12, lines 8-10 recites that “the resiliently contracted tape member 1 breaks into the eyelid 7 on which it is attached and forms an eyelid with a fold.” When the eyelid is folded, it necessarily is lifted from the eyeball. The present amendment hereby replaces the term “break” with “lift” in response to the comment in section 8 on page 4 of the Office Action.

The Office Action also takes the position that the specification does not describe the article as having an adhesive layer sufficient to prevent the tape, string, or elongate member from being detached when the tape member is adhered to the eyelid in the stretched state and subsequently recoiled back to form the double eyelid. Applicant notes that if the adhesive layer is not strong enough to hold the member to the eyelid, then the double eyelid could not be formed and the article would not work for its intended purpose. Therefore, it is respectfully submitted that the original specification necessarily supports the cited claim terms.

Applicant further notes that MPEP 2163 states, with regards to the written description requirement for new or amended claims, that “while there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.” In view of the above discussion, it is respectfully submitted that each of the claim terms identified in section 5 on page 3 of the Office Action are fully supported expressly, implicitly, or inherently by the original specification. Thus, it is respectfully requested that the rejection under 35 U.S.C. § 112, first paragraph be withdrawn.

Further, in view of the amendment to replace “break” with “lift” and the discussion above, it is respectfully submitted that each of the pending claims is fully definite, and no further rejection on that basis is anticipated. Thus, it is respectfully requested that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn. However, if the Examiner disagrees, Applicant respectfully requests that the Examiner telephone the undersigned representative who will be happy to work with the Examiner to derive mutually acceptable language.

In response to the rejections under 35 U.S.C. § 103(a), Applicant respectfully requests reconsideration of these rejections and traverses these rejections, as discussed below.

By way of review, the double eyelid forming articles recited in independent Claims 39, 45, and 51 are made of resin material having resilient shrinkability and formed into a shape of an elongate tape or a string in which an adhesive layer is provided on at least one of surfaces extending in the longitudinal direction of the tape or the string.

The double eyelid forming article forms a fold of the double eyelid through the following process:

(1) A user pinches both ends of the double eyelid forming article by his/her fingertips and then stretches the article in its longitudinal direction.

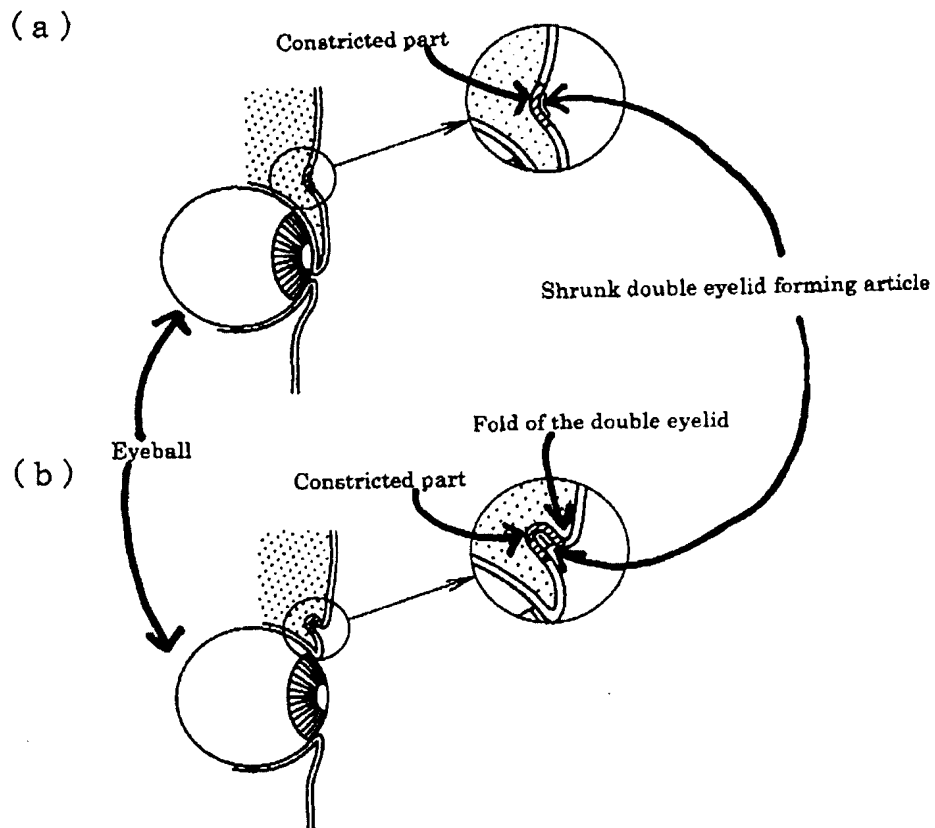
(2) The stretched double eyelid forming article is, while being stretched, pushed against a line of the skin of the eyelid along which the user wants to form a fold of the double eyelid. At the same time the user adheres the article onto the line, he/she pulls his/her fingertips away from the article.

(3) When the stretched double eyelid forming article shrinks in the longitudinal direction, the skin of the eyelid also shrinks in the same direction by the same length. In this time, the double eyelid forming article shrinks against tension of the skin of the eyelid. Therefore, the article shrinks against the tension of the skin because the resilient shrinkability of the tape member (or string member or elongate member) of the double eyelid forming article is larger than tension of the skin of the eyelid.

Incidentally, the skin of the eyelid is formed on a curved surface provided substantially along an eyeball. Therefore, on the curved surface of the skin, the circumferential length of the skin of a part onto which the double eyelid forming article is adhered becomes shorter by the amount of shrinkage of the double eyelid forming article. As a result, one *constricted part* (see Reference Fig. 2(a) provided below) like a concave groove is formed along the part onto which the double eyelid forming article is adhered.

REFERENCE FIG. 2

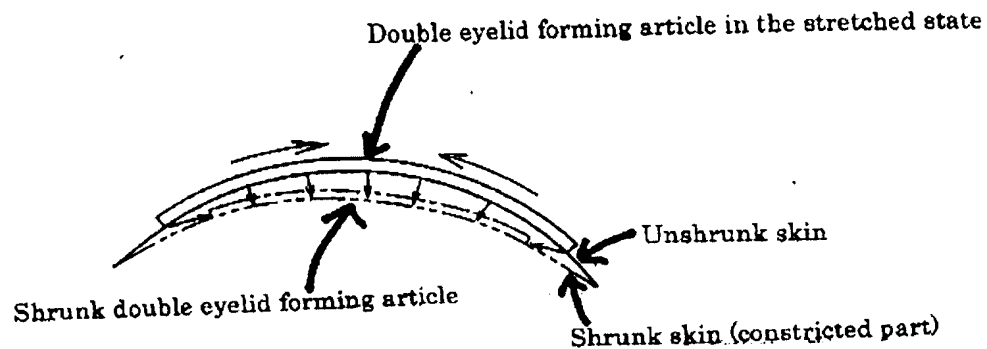
(Vertical sectional view of the eyelid onto which the double eyelid forming article of the present invention is applied)



This phenomenon is natural also in view of geometry as illustrated in Reference Fig. 1 provided below.

REFERENCE FIG. 1

(Sectional view of the skin of an eyelid taken along the longitudinal direction of the double eyelid forming article according to the present invention adhered onto the skin of the eyelid)



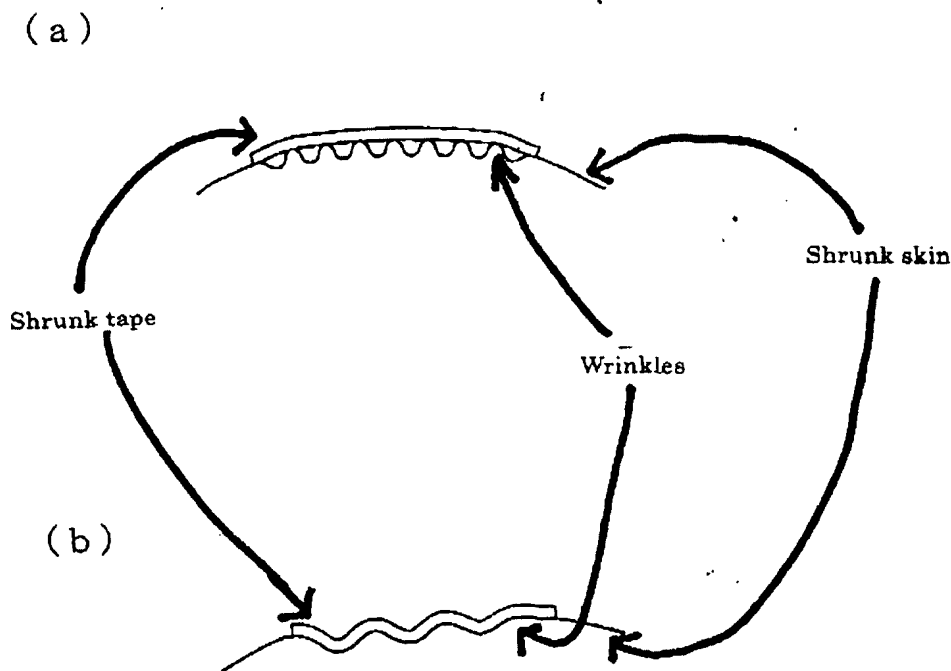
As can be seen in the reference figures above, the double eyelid forming article is received in the constricted part. This is a state in which the double eyelid forming article breaks or lifts the skin of the eyelid. When the user opens his/her eye, this constricted part constitutes a crease, and the skin above the constricted part covers the constricted part to thereby form a fold of a double eyelid (see Reference Fig. 2(b) provided above).

In contrast, as illustrated in Reference Figs. 3(a) or 3(b) provided below, when the resilient shrinkability of the tape is too large, the skin of the eyelid shrinks by an excessively large amount and the skin of the part onto which the article is adhered sags.

REFERENCE FIG. 3

(Sectional view of the skin when resilient shrinkability of the tape is excessively large)

Wrinkles



As a result, a large number of wrinkles (*not folds*) are formed in the direction perpendicular to the adhering direction of the tape, and therefore, it is impossible to form the constricted part and the fold of the double eyelid. Accordingly, to form the fold of the double eyelid, the resilient shrinkability of the tape member (or string member or elongate member) of the double eyelid forming article according to the claimed invention is smaller than a resilient shrinkability of the skin, as recited in independent Claims 39, 45, and 51.

Hodgson describes a surgical drape including a backing material 2 and an adhesive 4.¹ In section 17 on page 9, the Office Action takes the position that “It is reasonable to presume that the adhesive tape member of Hodgson has the aforementioned features including ‘resilient shrinkability’.” Further, the Office Action shifts the burden to Applicant to prove otherwise.

¹ See Hodgson, at column 10, lines 27 and 28 and in Figure 7.

In response, Applicant submits that Hodgson describes in lines 13 to 16 of column 7 that “One of the preferred uses of the present invention is in decorative cosmetic products, e.g., nail covers, eye liners, beauty spots, stage effects, e.g., wrinkle producers (attach to skin in stretched state).” This wrinkle is produced by forcibly fixing the wrinkle with a tape, the wrinkle being formed by hauling the skin by a finger, or is produced by strong shrinkability of the tape as illustrated in Reference Fig. 3. Thus, the surgical drape of Hodgson forms a large number of wrinkles, *and does not form a fold*, in the direction perpendicular to the adhering direction (stretching direction) of the tape. Further, Hodgson is silent regarding forming such a fold. Accordingly, Applicant respectfully submits that the presumption in section 17 on page 9 of the Office Action is incorrect and should be withdrawn.

In addition, a person of ordinary skill in the art would know that the tension of the skin of the eyelid is extremely small compared with tension of a skin of other body parts. Thus, something that would produce wrinkles in the skin would certainly produce wrinkles on the eyelid, not a fold, which requires less shrinkability of the attached article.

Specifically, the fold, which is a constricted part like a concave groove, can be formed only by an extremely small shrinkability of the following range: larger than the tension of the skin of the eyelid and smaller than the shrinkability. Accordingly, the depth of the constricted part is shallower than the depth of an actual wrinkle. Therefore, the artificially formed constricted part is unnoticeable when a user closes his/her eye.

Accordingly, the fold of the double eyelid formed by the resiliently stretchable member recited in the independent claims is completely different from the surgical drape which produces the wrinkle of Hodgson.

Further, Hodgson also describes in lines 13 to 16 of column 7 that the tape can be used as cosmetic products such as eye liners. However, the eye liner is completely different from an article that forms a fold of the double eyelid, and hence, this description merely

suggests that a colored tape is just adhered onto the brinks of eyelids without forming any folds.

Accordingly, it is respectfully submitted that Hodgson does not disclose or suggest every feature recited in the independent claims. Thus, it is respectfully requested that the rejection of independent Claims 39 and 51, and all claims dependent thereon, as unpatentable over Hodgson be withdrawn.

Clavin describes an adhesive strip 32 configured to hold the skin of the upper eyelid 10 which is pulled gently down by the fingers of a user over the adhesive strip 32 to reduce bagging of the upper eyelid 10.² Accordingly, the adhesive strip 32 described in Clavin is first placed on the eyelid 10, and then a user folds the eyelid 10 over the adhesive strip 32.

Clavin is silent with regard to first stretching the strip 32, and then allowing the resilient shrinkability to overcome the tension of the skin of the eyelid to form a double eyelid as the strip 32 returns to its original size. Although Clavin describes that the adhesive strip 32 can be formed of polyethylene, it is noted that there are many different types of polyethylene with different structural properties such that the adhesive strip 32 does not inherently have resilient shrinkability larger than a tension of the skin. Several double eyelid forming tapes are commercially available, including tapes sold by Daiso Japan and Samasa Ma-Na, which form double eyelids by the same method described in Clavin. These tapes are made of polyethylene such as PET and do not have the resilient shrinkability to form a fold when stretched and attached to the skin.

Further, unlike the claimed tape member, the polyethylene described in Clavin is not required to have resilient shrinkability. Thus, while the claimed string member has a specific resilient shrinkability, the adhesive strip 32 of Clavin can perform its intended functions

² See Clavin, at column 4, lines 26-35, at column 6, lines 18-30, and in Figures 6-9 and 16.

without having the same resilient shrinkability. Therefore, the adhesive strip 32 of Clavin does not explicitly or inherently have the claimed resilient shrinkability. See MPEP 2112.

It is also noted that an increased force would be placed on the adhesive layer during shrinking as compared to the adhesive strip 32 of Clavin, which has the skin folded to it. Thus, there is no disclosure in Clavin that the adhesive on the strip 32 could hold onto the skin during the shrinking.

Independent Claim 45 also recites that “the individual side edges of the first surface and the second surface are each in linear forms in parallel to each other along the whole longitudinal direction of the string member when the string member is in the unstretched state, cross sections of the first surface and the second surface perpendicular to the longitudinal direction of the string member each have outwardly protruding arcuate shapes along the entire longitudinal direction of the string member when the string member is in the unstretched state, the cross sections each have a uniform form along the whole longitudinal direction of the string member when the string member is in the unstretched state.”

The Office Action in section 25 takes the position that certain elements in Claim 45 are disclosed in Figures 13 and 15 of Clavin or are an “obvious optimization to one of ordinary skill in the art, motivated by the desire to produce a string member that can be suitably applied to eyelids.” Applicant again respectfully traverses this assertion.

On the contrary, in the double eyelid forming product of the type to simply stick as described in Clavin, a person of ordinary skill in the art reading Clavin would understand that it is necessary to stick the tape to the eyelid along the three-dimensional shape of the eyeball. Thus, a curve of at least a portion of the side edges is an indispensable requirement in Clavin and the tape with linear side edges entirely parallel to each other is not a part of the double eyelid forming product. Accordingly, a person of ordinary skill in the art reading Clavin would not find it obvious to optimize the adhesive strip 32 to have the claimed dimensions.

Therefore, it is respectfully submitted that Clavin does not disclose or suggest every feature recited in independent Claim 45. Thus, it is respectfully requested that the rejection of Claim 45, and all claims dependent thereon, as unpatentable over Clavin be withdrawn.


Further, regarding the position taken in section 11 on page 6 and section 23 on page 11 of the Office Action, Applicant respectfully traverses this position. The Office Action states that “any reference disclosing a tape member that is resiliently stretchable (i.e. elastic) having...will read on the claims.” In view of the above discussion, it is again noted that the claimed tape, string, or elongate member has a range of resilient shrinkability that the cited references do not disclose or suggest.

Turning now to the rejections of Claims 47, 49, 59, and 61, it is noted that these claims are dependent on independent Claims 39, 45, and 51. Accordingly, these claims are believed to be patentable for at least the reasons discussed above with respect to Claims 39, 45, and 51. Further, it is respectfully submitted that none of the secondary references (Samuelsen, Hodgson, and Berglund) cure the above-noted deficiencies of Clavin and Hodgson. Thus, it is respectfully requested that the rejections of Claims 47, 49, 59, and 61 be withdrawn.

Consequently, in view of the above discussion, no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

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A handwritten signature in dark ink, appearing to read 'Colin B. Harris', is written over a horizontal line.

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